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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/871,605

06/01/2001

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38834 7590 12/20/2007

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EXAMINER

CHOI, PETER H

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

12/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/871,605	Applicant(s) TERAMACHI, AKIHIRO	
	Examiner Peter Choi	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The following is a **FINAL** office action upon examination of application number 09/871,605. Claims 1, 3-7, and 9-12 are pending in the application and have been examined on the merits discussed below.

Response to Amendment

2. In the amendments to the claims received October 9, 2007, claims 1 and 7 have been amended.

Response to Arguments

3. Applicant's arguments filed October 9, 2007 have been fully considered but they are not persuasive.

Applicant argues that Eisenhart does not teach the step of registering the information about the applicant into a membership database for the human operator, which is an entity separate from the applicant, on at least the condition that the applicant should have passed the examination operation.

The Examiner respectfully disagrees. Eisenhart teaches the step of registering information about users of a system into a membership database (**Registration component 321 accepts identification information from potential member 305, and stores the identification information in database 340**). Information is registered

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for all users of the system, including users requesting information (i.e., a human operator of the claimed invention) from an expert in the community, and applicants seeking membership into the community (i.e., potential members) so that they may provide information requested by users. All users are registered as members on the condition of passing the examination operation (**Registration component 321 then signals qualification component 322 to determine whether potential member 305 qualifies as member 306**) Eisenhart also teaches the step of providing users requesting information (i.e., the human operator of the claimed invention) with a list of expert members who have passed the examination operation and are available to provide the information requested by users (**Once qualified, member 306 may access member login section 317 to access to home page 323 on community web site 320; Directory browsing component 430 provides member 306 profile listings using the anonymous data in the personal profiles to list qualified Buyers and expertise Contributors in a given technology**) [Paragraphs 13, 45, 46, 54]. Thus, the Examiner asserts that Eisenhart does indeed teach the step of registering information about an applicant into a membership database on the condition that the applicant has passed the examination operation, and providing a list of applicants who have passed the examination operation (i.e., "expert members") to a user requesting information.

Applicant argues that the qualification standards for access in Eisenhart is not a standard of requestors who seek information, as in the claimed invention; therefore, in Eisenhart, it is not possible to collect valuable information effectively, whereas in the

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claimed invention, it is possible to differentiate handling of members by ranking them into several levels in accordance with an examination result.

The Examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., differentiating members by ranking them into several levels in accordance with an examination result, collecting valuable information effectively) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed invention sets forth examination requirements set by a human operator so that the applicant of a level desired by the human operator passes the examination operation performed on reported information. There is no limitation setting forth a plurality of levels into which members can be ranked; thus, the "level" of applicant is deemed to be directed towards members, applicants who have passed the examination operation.

Applicant argues that one of ordinary skill in the art at the time of the claimed invention would not have been motivated to combine Eisenhart and Dworkin.

In response to applicant's argument concerning improper motivation to combine references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make

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the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, the examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in In re Sheckler, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Even if the references in the instant case do not expressly suggest the specific combination claimed by the inventor, an assertion which the examiner contests, the courts have stated "to support [a] conclusion that claimed combination is directed to obvious subject matter, references must either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings." Ex parte Clapp, 227 USPQ 972, 973 (BdPatApp&Int 1985). Furthermore, The Courts have already established that "[h]aving established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'" In re Bozek, 163 USPQ 545, 549

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(CCPA 1969). Furthermore, KSR forecloses Applicant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

In the instant case, Eisenhart allows members to browse a directory listing of member and project profiles that include more information than was available from the pedestrian website [Paragraph 14]. Members can request direct contact with potential business partners to advance the evaluation for a potential partnership. Eisenhart also provides directory browsing component 430 that provides member 306 profile listings using the anonymous data in the personal profiles to list qualified Buyers and expertise Contributors in a given technology. Directory browsing component includes additional detail in the listing, such as a full description, project stage, and keywords. In addition, directory browsing component 430 provides advanced search criteria and refined search term interface, links to the member profile, and listings that display the most recently created member 306 profile. Screening and match-making component 440 compares the member 306 profile to the other profiles in the community using a dual or bi-directional matching algorithm to determine which community members or projects are likely to be a good match. Each member 306 completes a detailed personal profile that is tailored to the active role for member 306, which is used to express their technology interests and describe their technology competencies [Paragraphs 54-57, and 60]. Dworkin et al. also allows users to select an expert respondent to exchange ideas and information [Column 2, lines 7-10] and can also be programmed to direct the

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question to a particular expert respondent. The key words appearing in a question may be analyzed and compared with the key words appearing in a biography of the expert [Column 7, lines 11-19]. Both Eisenhart and Dworkin et al. are linked through their mutual teachings of selecting specific participants for collaboration in exchanging information. Dworkin et al. discloses the use of human operators and the usefulness of providing users with the opportunity to direct a question to an expert of his or her choice in the scenario of there being more than one expert available at the same time [Column 7, lines 8-10], which is a feature lacking in Eisenhart. Thus, as Eisenhart and Dworkin et al. are both directed towards the same field of endeavor and contain many similar features for matching prospective candidates for collaborative information exchange, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine the teachings of Eisenhart and Dworkin et al.

4. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Specifically, arguments made by the Applicant, with respect to newly amended limitations, are addressed in the updated Office Action below. Applicant argues that, as amended, Eisenhart in view of Dworkin does not disclose:

performing examination operation on the reported information in connection with membership registration, the examination operation being based on examination

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requirements set by a human operator so that the applicant of a level desired by the human operator passes the examination operation.

Official Notice

As stated in the previous Office Action mailed November 29, 2005, the Applicant did not challenge the Official Notice cited in the Office Action mailed June 15, 2005.

Those statements have been admitted as prior art. Specifically, it has been admitted as prior art that:

- It is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.).

In the previous Office Action mailed May 10, 2007, notice was taken by the Examiner that certain subject matter is old and well known in the art. Per MPEP 2144.03(c), these statements are taken as admitted prior art because no traversal of this statement was made in the subsequent response. Specifically, it has been taken as prior art that:

- It is old and well known in the art for an intermediary (i.e., a human operator) to match service requesters (users) with service providers (i.e., experts) according to the skills and expertise of said service providers

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 37, and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 claims the step of "performing examination operation on the reported information in connection with membership information, the examination operation being based on examination requirements set by a human operator so that the applicant of a level desired by the human operator passes the examination operation". Based on the Applicant's arguments, the claimed subject matter is unclear, specifically, whether the performing of an examination operation is claimed, or the setting of examination requirements by a human operator. For examination purposes, it is assumed that the claimed invention as defined by claim 1 is intended to allow human operators to specify examination requirements, and for an examination operation to be performed based on said examination requirements. Clarification is required.

Similarly, claim 7 claims "means for registering the information about the applicant into a membership database for a human operator, which is an entity separate from the applicant, at least on the condition that the applicant has passed the examination, the examination being based on examination requirements set by the

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human operator so that the applicant of a level desired by the human operator passes the examination". The claimed subject matter is unclear, specifically, whether the registration of information about applicants passing an examination into a membership database is claimed, or the setting of examination requirements by a human operator. For examination purposes, it is assumed that the claimed invention defined by claim 7 is intended to allow human operators to specify examination requirements, and for the registration of information about applicants passing an examination into a membership database. Clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhart (PGPub 2001/0047276) in view of Stephanous (US Patent #6,513,013) and Dworkin et al. (U.S Patent #6,026,148).

As per claim 1, Eisenhart teaches an open research and development method comprising the steps of:

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sending membership solicitation information (**registration data**) to a communications network (**using Internet 100**) from a predetermined server (**at a web-based presentation interface on a pedestrian web site**) [Paragraphs 12 and 31];

causing an applicant for membership to report predetermined items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) from a network terminal (**computer**) operated by the applicant, by way of the communications network (**using Internet 100**) [Paragraphs 12 and 105];

performing examination operation (**verification of qualifications**) on the reported information (**registration data, contact information**) in connection with membership registration [Paragraphs 12, 45 and 105];

registering the information about the applicant into a membership database (**Registration component 321 accepts identification information from potential member 305, and stores the identification information in database 340**) for the human operator, which is an entity separate from the applicant **{this is performed for all users of the system, including users requesting information, and users seeking to become registered members, i.e, "expert applicants", who can be selected to provide the information requested by users}**, on at least the condition that the applicant should have passed the examination operation (**Registration component 321 then signals qualification component 322 to determine whether potential members 305 qualifies as member 306.... Once qualified, member 306 may access member login section 317 to access to home page 323 on community**

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web site 320; Directory browsing component 430 provides member 306 profile listings using the anonymous data in the personal profiles to list qualified Buyers and expertise Contributors in a given technology) [Paragraphs 13, 45, 46, 54]; and accumulating, into a knowledge database (**collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library**) , information which has been transmitted from members (**technology asset 226, technology project 228, and confidential data such as technical documents, test results, and empirical studies**) registered in the membership database by way of the communications network in relation to a specific topic (**organized by topic, type of deal sought, targeted industry segment**) [Paragraphs 33, 52, 54].

Eisenhart does not explicitly disclose that the examination operation is based on examination requirements set by a human operator so that the applicant of a level desired by the human operator passes the examination operation.

However, Stephanou teaches the step of allowing a user requesting information to specify the qualifications of an expert to provide assistance **{users submit a request for assistance ticket requiring an expert having specific qualifications}**, and to conduct an examination to determine whether an applicant meets the qualifications of an expert that provides assistance (**An expert initially logs onto the system of the present invention and signs up to become an expert 160 who can be called upon to satisfy various tickets. The system of the present invention then sends an e-**

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mail to the expert 162 confirming his registration and informing his registration and informing his of the pending assessment of the expert qualifications, and that this will take place **BEFORE** the expert is assigned any tickets by the system. In this way the entity managing the server of the present invention ascertains the expert's qualifications and areas of expertise. If the expert is not qualified in any of the areas in which the system responds to customer members an e-mail is sent to the experts so notifying the expert. If the expert has the requisite qualifications a confirmation e-mail is sent to the expert 168 and the expert is then logged onto the system) [Column 7, lines 5-19, Claim 1].

Both Eisenhart and Stephanou are analogous references directed towards providing collaboration and exchange of information between parties over the Internet. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of allowing a human operator to set the examination requirements in determining whether to grant applicants membership, because doing so enhances the ability of Eisenhart to provide a better match between Suppliers and Buyers, which is a goal of Eisenhart [abstract].

Eisenhart teaches the steps of compiling a list of members by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraphs 14 and 55] and teaches the step of transmitting engineering information by means of a communications network (**Supplier**

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server 222 connects to Internet 100 and provides access to technology asset 226, technology project 228, and confidential data such as technical documents, test results, and empirical studies) [Paragraph 33], but does not explicitly teach the step of using a human operator to select members and to request engineering information from said selected members.

However, Dworkin et al. allows for an expert respondent to be selected manually by the user or automatically by the system [Column 2, lines 7-9]. Dworkin et al. enables the user to be given the opportunity to direct a question to an expert of his or her choice. [Column 7, lines 10-11]. Since the user specifies a subject that has a plurality of members that are experts in said subject, said user (or "operator", as per the Applicant's definition of "operator" in the specification) has thereby selected members to request information from. Therefore, both the computer logic and the user ("operator") of Dworkin et al. are used to select members from which to request information.

Eisenhart, Stephanou and Dworkin et al. are directed towards the electronic exchange of expert information; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of the Eisenhart-Stephanou combination to include the ability to select members to request information from based on membership information about each expert, because the resulting combination would facilitate the pairing of said user with an expert able to answer said user's question based on said expert's membership information and areas of expertise,

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further providing users with the opportunity to direct a question to an expert of his or her choice in the scenario of there being more than one expert available at the same time.

Furthermore, the “engineering” information recited in claim 1 is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same regardless of the type of data exchanged. Further, the structural elements remain the same regardless of the type of data exchanged. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

As per claim 3, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

submitting given inquiries to the applicant (**request for registration data**) by way of the communications network (**Internet 100**) [Paragraphs 12 and 31]; and

determining whether to register the applicant as a member (**qualifying the potential member**), on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12 and 45].

As per claim 4, Eisenhart teaches the open research and development method according to claim 1 or claim 3, wherein the items to be reported by the applicant

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include items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 5, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

concluding a secrecy memorandum (**exclusive review agreement and nondisclosure agreement**) with the applicant who has passed the examination operation (**member**) [Paragraphs 15 and 90]

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). It has been admitted as prior art, as a result of improperly and/or untimely challenged Official Notice, that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum.

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However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 6, Eisenhart teaches the open research and development method according to claim 1, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

As per claim 7, Eisenhart teaches an open research and development system comprising:

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means (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) for sending membership solicitation information (**registration data**) to a communications network (**through the pedestrian web site**) [Paragraphs 12, 31, 38 and 41];

means (**Internet 100, mail server 301, pedestrian website 310 and private mail server 350**) for sending items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) to be reported at time of application for membership to a network terminal (**computer**) operated by an applicant, by way of the communications network (**Internet 100**) [Paragraphs 12, 38, 41, and 105];

means for acquiring the items (**registration component 321 receives registration and identification data**) which are transmitted from the network terminal by way of the communications network (**Internet 100**) and for performing an examination (**verification of qualifications by qualification component 322**) in connection with membership registration on the basis of the received information (**registration data, contact information**) [Paragraphs 12, 45 and 105];

means for registering the information about the applicant into a membership database (**Registration component 321 accepts identification information from potential member 305, and stores the identification information in database 340**) for a human operator, which is an entity separate from the applicant (**this is performed for all users of the system, including users requesting information, and users seeking to become registered members, i.e., "expert applicants", who can be**

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selected to provide the information requested by users}, on at least the condition that the applicant should have passed the examination operation **(Registration component 321 then signals qualification component 322 to determine whether potential members 305 qualifies as member 306.... Once qualified, member 306 may access member login section 317 to access to home page 323 on community web site 320; Directory browsing component 430 provides member 306 profile listings using the anonymous data in the personal profiles to list qualified Buyers and expertise Contributors in a given technology)** [Paragraphs 13, 45, 46, 54]; and means **(Collaboration Manager 325 containing Directory browsing component 430 and Custom feed component 410)** for accumulating, into knowledge database **(collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library)**, information which pertains to a certain topic **(organized by topic, type of deal sought, targeted industry segment)** and which has been sent from a member registered in the membership database **(member with member profile listed)** by way of the communications network **(Internet 100)** [Paragraphs 51-52,54-55].

Eisenhart does not explicitly disclose that the examination operation is based on examination requirements set by a human operator so that the applicant of a level desired by the human operator passes the examination operation.

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However, Stephanou teaches the step of allowing a user requesting information to specify the qualifications of an expert to provide assistance **{users submit a request for assistance ticket requiring an expert having specific qualifications}**, and to conduct an examination to determine whether an applicant meets the qualifications of an expert that provides assistance **(An expert initially logs onto the system of the present invention and signs up to become an expert 160 who can be called upon to satisfy various tickets. The system of the present invention then sends an e-mail to the expert 162 confirming his registration and informing his registration and informing his of the pending assessment of the expert qualifications, and that this will take place BEFORE the expert is assigned any tickets by the system. In this way the entity managing the server of the present invention ascertains the expert's qualifications and areas of expertise. If the expert is not qualified in any of the areas in which the system responds to customer members an e-mail is sent to the experts so notifying the expert. If the expert has the requisite qualifications a confirmation e-mail is sent to the expert 168 and the expert is then logged onto the system)** [Column 7, lines 5-19, Claim 1].

Both Eisenhart and Stephanou are analogous references directed towards providing collaboration and exchange of information between parties over the Internet. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of allowing a human operator to set the examination requirements in determining whether to grant applicants

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membership, because doing so enhances the ability of Eisenhart to provide a better match between Suppliers and Buyers, which is a goal of Eisenhart [abstract].

Eisenhart teaches the steps of compiling a list of members by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraphs 14 and 55] and teaches the step of transmitting engineering information by means of a communications network (**Supplier server 222 connects to Internet 100 and provides access to technology asset 226, technology project 228, and confidential data such as technical documents, test results, and empirical studies**) [Paragraph 33], but does not explicitly teach the step of using a human operator to select members and to request engineering information from said selected members.

However, Dworkin et al. allows for an expert respondent to be selected manually by the user or automatically by the system [Column 2, lines 7-9]. Dworkin et al. enables the user to be given the opportunity to direct a question to an expert of his or her choice. [Column 7, lines 10-11]. Since the user specifies a subject that has a plurality of members that are experts in said subject, said user (or "operator", as per the Applicant's definition of "operator" in the specification) has thereby selected members to request information from. Therefore, both the computer logic and the user ("operator") of Dworkin et al. are used to select members from which to request information.

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Eisenhart, Stehpanou and Dworkin et al. are directed towards the electronic exchange of expert information; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of the Eisenhart-Stephanou combination to include the ability to select members to request information from based on membership information about each expert, because the resulting combination would facilitate the pairing of said user with an expert able to answer said user's question based on said expert's membership information and areas of expertise, further providing users with the opportunity to direct a question to an expert of his or her choice in the scenario of there being more than one expert available at the same time.

Furthermore, the "engineering" information recited in claim 1 is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same regardless of the type of data exchanged. Further, the structural elements remain the same regardless of the type of data exchanged. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

As per claim 9, Eisenhart teaches the open research and development system according to claim 7, wherein the means for sending items (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) to be reported at the time

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of application for membership submits given inquiries (**request for registration data**) to the applicant by way of the communications network (**Internet 100**) [Paragraphs 12 and 31, 38 and 41]; and the means for performing an examination (**verification of qualifications by qualification component 322**) performs an examination (**qualifying the potential member**) on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12, 45 and 105].

As per claim 10, Eisenhart teaches the open research and development system according to claim 7, wherein the items to be reported for application by the applicant includes items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 11, Eisenhart teaches the open research and development system according to claim 7, further comprising:

means (**Secure collaboration manager 331 and Contract manager 530**) for submitting a secrecy memorandum (**exclusive review agreement and nondisclosure agreement**) to the applicant who has passed the examination operation (**member**), by way of the communications network [Paragraphs 15, 84 and 90]; and

means (**Deal tracker component 450, which contains acceptance component 458**) for determining whether or not the involved parties have agreed on the secrecy memorandum (**when a supplier and either a buyer or contributor reach an agreement during the course of the negotiation of a notarized document of an**

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exclusive review agreement) on the basis of the information transmitted from the network terminal in response to the submitted secrecy memorandum [Paragraphs 63, 83-86] .

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). It has been admitted as prior art, as a result of improperly and/or untimely challenged Official Notice, that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

As cited above, Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have

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such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 12, Eisenhart teaches the open research and development system according to claim 7, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are directed towards electronic information exchange between distinct parties:

- Goedken (US Patent #6,393,423)
- Nielsen (US Patent #5,948,054)

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- Taylor (US Patent #5,832,497)
- Marks et al. (USPGPub 2003/0163356)
- Rossides (US Patents #6,131,085 and 6,856,986)
- Silverman et al. (US Patent #5,924,082)

The following references are directed towards authenticating and registering background data of users:

- Shapiro et al. (US Patent #6,714,944)

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 14, 2007


C. MICHELLE TARAE
PRIMARY EXAMINER

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